

Application No.: 10/764,571Docket No.: 713-1029**AMENDMENTS TO THE DRAWINGS:**

The attached replacement sheet of drawings includes changes to the Figure, to which new numeral references "20" and a phantom line associated with one of the new reference numerals have been added.

**Attachment:**

- Replacement Sheet

**Application No.: 10/764,571****Docket No.: 713-1029****REMARKS**

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. Entry of this Amendment under Rule 116 is merited as it raises no new issues and requires no further search.

Claims 1-6 and 8-20 are pending in the application. Claim 7 has been cancelled without prejudice or disclaimer. Claims 8 and 17 have been rewritten in independent form including all limitations of base claim 7. The remaining claims are unchanged, notwithstanding the Examiner's rejections manifested in the Final Office Action. The specification and the only drawing have been amended to be consistent with each other. The changes find support in the original specification, especially at page 3, the last sentence. No new matter has been introduced through the foregoing amendments.

**The finality of the Office Action mailed May 24, 2005 is deemed premature and should be withdrawn.** In particular, the Examiner's new ground of rejection raised against claim 1 was not necessitated by Applicant's amendments.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). *See MPEP*, section 706.07(a) (emphasis added).

In this case, claim 1 was amended by the April 25, 2005 Amendment mostly to improve claim language and to place the claim in commonly accepted US claim format, without touching the merits. *See* lines 1-11 of amended claim 1 in the April 25, 2005 Amendment, and attached *Exhibit B* which is a claim chart comparing the original version of claim 1 with its amended version introduced by the April 25, 2005 Amendment. The only exception involves the deletion of the last

**Application No.: 10/764,571****Docket No.: 713-1029**

phrase of original claim 1. However, the literal scope of claim 1 was broadened by this amendment. This means, the rejection of original claim 1 as manifested in the January 25, 2005 Office Action could have been reapplied (if the rejection had been proper) without requiring the new ground of rejection. Apparently, the withdrawal of the January 25, 2005 Office Action's rejection of original claim 1 and the introduction of the May 24, 2005 Office Action's new ground of rejection against amended claim 1 were not necessitated by Applicants' broadening amendment. Therefore, the May 24, 2005 Office Action should not be made final.

In addition, the new ground of rejection of claim 1 is based on references (i.e., U.S. Patent No. 6,354,779 to *West* and U.S. Patent No. 5,980,169 to *Hinch*) which are not information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Therefore, the May 24, 2005 Office Action should not be made final.

For the above advanced reasons, withdrawal of the finality of the May 24, 2005 Office Action is believed appropriate and, therefore, courteously solicited.

Should the Examiner insist that the finality of the May 24, 2005 Office Action is proper, he is kindly asked to specify, with reference to attached *Exhibit B*, the limitation(s) that necessitated the new ground of rejection.

The objection to the drawing and the 35 U.S.C. 112, *second paragraph* rejection of claims 14 and 20 are believed overcome in view of the above amendments.

The new art rejections of claims 1-20 as being obvious over *West* in view of *Hinch* are traversed, because the applied references, especially *Hinch*, clearly fail to teach or suggest "a flat surface forming the wall of a central drilling tooth and of one of two lateral drilling teeth" as recited in independent claim 1, and "each of said lateral drilling teeth having a flat surface being an extension of one of the flat surfaces of said central drilling tooth" as recited in independent claims 8

**Application No.: 10/764,571****Docket No.: 713-1029**

and 17.

In particular, the Examiner admitted that the *West* patent does not anticipate the claimed invention. Namely, *West* fails to teach or disclose a flat surface (17 in the Figure of the instant application) which forms the wall of both the central drilling tooth (14 in the Figure of the instant application) and one of the two lateral drilling teeth (15 in the Figure of the instant application). The Examiner allegedly found the missing element in *Hinch*, at element 28 (FIG. 2), and concluded that it would have been obvious to combine the *Hinch* drilling teeth with the *West* bolt to arrive at the claimed invention. Applicants respectfully disagree, because the Examiner's reading of the *Hinch* reference is erroneous.

Specifically, *Hinch* explicitly teaches two substantially planar surfaces 36, 38 at column 3, lines 8-9. However, the surfaces are angled relative to each other (FIG. 5 of *Hinch*) and, therefore, do not read on the claimed flat surface/extension. More specifically, each substantially planar surface 36 (FIG. 5 of *Hinch*) does not form the wall of any of the two lateral drilling teeth (28, FIG. 5 of *Hinch*) as required by independent claim 1. Likewise, each substantially planar surface 38 (FIG. 5 of *Hinch*) is not an extension of any of the flat surfaces (36, FIG. 5 of *Hinch*) of the central drilling tooth (24, FIG. 5 of *Hinch*), as required by independent claims 8 and 17.

Other surfaces of the *Hinch* boring tip, i.e., 32 and 42 (FIG. 6 of *Hinch*), are curved rather than flat. See also column 3, line 16 of *Hinch*.

Still other surfaces of the *Hinch* boring tip, i.e., surfaces A and B in attached *Exhibit C* which is an annotated version of FIGs. 2 and 6 of *Hinch*, are not described the text of the *Hinch* patent as being planar. The surfaces A and B are, however, disclosed in FIG. 6 of *Hinch* as being curved. See *Exhibit C* at shading C. (A planar surface must be shaded as shown at the left reference numeral 38 in FIG. 6 of *Hinch*.) Thus, surfaces A and B of *Hinch* are neither readable on the claimed "flat surface forming the wall of a central drilling tooth and of one of two lateral

**Application No.: 10/764,571****Docket No.: 713-1029**

drilling teeth" of independent claim 1, nor the claimed "flat surface being an extension of one of the flat surfaces of said central drilling tooth" of independent claims 8 and 17. Worse, surfaces A and B are not continuous extensions of each other due to the boundary line designated at D in *Exhibit C*.

Therefore, even if *West* and *Hinch* were properly combinable in the manner the Examiner proposed, which Applicants contend to the contrary, the resulting bolt would still fail to teach or disclose the highlighted claim limitations. The obviousness rejections of claims 1-6 and 8-20 are inappropriate and should be withdrawn.

Accordingly, all claims in the present application are believed in condition for allowance. Early and favorable indication of allowance is courteously solicited.

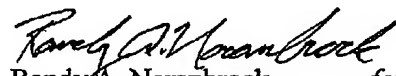
The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

**Application No.: 10/764,571****Docket No.: 713-1029**

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

**LOWE HAUPTMAN & BERNER, LLP**



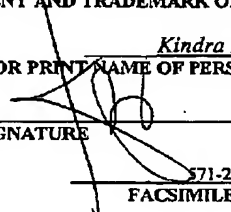
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